

fourteen days of service of the appellant's notice of appeal under paragraph (b) of this section, or notice of cross appeal under paragraphs (c) or (d) of this section, take the following steps:

(1) In the U.S. Patent and Trademark Office, timely file a written notice directed to the Director electing to participate in the appellant's appeal to the U.S. Court of Appeals for the Federal Circuit by mail to, or hand service on, the General Counsel as provided in § 104.2;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice electing to participate in accordance with the rules of the U.S. Court of Appeals for the Federal Circuit; and

(3) Serve a copy of the notice electing to participate on every other party in the reexamination proceeding in the manner provided in § 1.248.

(f) Notwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the Board of Patent Appeals and Interferences to the U.S. Court of Appeals for the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the U.S. Court of Appeals for the Federal Circuit.

[68 FR 71008, Dec. 22, 2003]

CONCURRENT PROCEEDINGS INVOLVING SAME PATENT IN *Inter Partes* REEXAMINATION

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was in-

involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

§ 1.989 Merger of concurrent reexamination proceedings.

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

§ 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171

through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§1.902 through 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent.

§ 1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.

If a patent in the process of *inter partes* reexamination is or becomes involved in an interference, the Director may suspend the *inter partes* reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion under §41.121(a)(3) of this title to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

[69 FR 50002, Aug. 12, 2004]

§ 1.995 Third party requester's participation rights preserved in merged proceeding.

When a third party requester is involved in one or more proceedings, including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third party requester's right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding

shall be served on all other parties of the merged proceeding.

REEXAMINATION CERTIFICATE IN *Inter Partes* REEXAMINATION

§ 1.997 Issuance of *inter partes* reexamination certificate.

(a) Upon the conclusion of an *inter partes* reexamination proceeding, the Director will issue a certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued in each patent in which an *inter partes* reexamination proceeding has been ordered under §1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be sent to the patent owner at the address as provided for in §1.33(c). A copy of the certificate will also be sent to the third party requester of the *inter partes* reexamination proceeding.

(d) If a certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *inter partes* reexamination proceeding is terminated by the grant of a reissued patent as provided in §1.991, the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 316.

(f) A notice of the issuance of each certificate under this section will be published in the *Official Gazette*.

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

EDITORIAL NOTE: Part 2 is placed in the separate grouping of parts pertaining to trademarks regulations.

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

Sec.
3.1 Definitions.